

PATENT APPLN. NO. 09/830,215
RESPONSE UNDER 37 C.F.R. §1.111

**PATENT
NON-FINAL**

REMARKS

Claims 23 and 24 are objected to in the Action because the unit of average particle diameter is erroneously recited as "mm" instead of the correct unit -- μ m--. Claims 23 and 24 are amended herein to correct this error.

Claims 1-3, 9-10, 14-16 and 25-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kinoshita et al. (U.S. Patent No. 5,527,594) ("Kinoshita") in view of Hatada. The Office notes first that Kinoshita discloses a polyester film substrate with a coating layer (A) formed on one side of the substrate and a coating layer formed on the other side of the substrate (citing Col. 2, lines 40-52). The Office notes, second, that the (A) layer is composed of a resin binder and a lubricant (citing Col. 4, lines 32-33) and that suitable resin binders include PET and PEN. The Office notes, third, that various additives including heat resistant resins such as polyetherimide may be incorporated into "the (A) layer" (Action, paragraph 8, line 3) so as to prevent oligomer deposition (citing Col. 15, lines 32-38, and Col. 17, lines 17-21). The Office concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize polyetherimide in the A layers of Kinoshita, as the reference explicitly teaches that polyetherimide

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is suitably used in these layers." (Action, page 4, paragraph 9, lines 1-3). Applicants understand from the statement in paragraph 9 of the Action that it is the position of the Office that it would have been obvious to one of ordinary skill in the art to utilize polyetherimide in the coating layer (A) of Kinoshita which contains a polyester binder resin.

Applicants respectfully submit that the Office is improperly picking and choosing from different and distinct embodiments of the polyester substrate used in the invention of Kinoshita based on a hindsight reconstruction of the biaxially oriented film of the present invention.

Kinoshita discloses at least six different embodiments of the polyester substrate used in the invention. These substrates are described as follows:

"(1) A polyester film having a coating layer (A) of a center line average roughness (Ra^A) of 0.005 to 0.5 μm ." (Col. 4, lines 30-31).

"(2) A polyester film having a thin polyester film (A) co-extruded therewith of a center line average roughness (Ra^A) of 0.005 to 0.5 μm ." (Col. 8, lines 16-18).

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"(3) A polyester film having a center line average roughness (Ra^A) on at least one side of 0.005 to 0.5 μm ." (Col. 9, lines 26-27).

"(4) A substrate having a surface of a center line average roughness (Ra^A) of 0.005 to 0.5 μm thereon of [sic] the opposite side to the optical recording layer and a surface of a center line average roughness (Ra^B) of not more than 0.005 μm thereon of the optical recording layer side, and a coefficient of dynamic friction between both sides (A) and (B) of not more than 1.0." (Col. 9, lines 47-53).

"(5) A polyester film with a center line average roughness (Ra) of not more than 0.05 μm is used as base film, and a coating layer (B) or a co-extruded polyester film (B) is formed on surface of the the optical recording layer side of the said polyester film as the base film so as to afford the specified surface characteristic, viz. a center line average roughness (Ra^B) of not more than 0.005 μm , to the surface thereof. On the surface on the opposite side to the coating layer (B) or the co-extruded polyester film (B) on the polyester film as the base film, a coating layer (A) or a co-extruded polyester film (A) is formed to afford the specified

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surface characteristic, viz. a center line average roughness (Ra^A) of 0.005 to 0.5 μm ." (Col. 14, lines 11-22).

"(6) A polyester film with a center line average roughness (Ra) of not more than 0.05 μm is used as base film, and a coating layer (A) or a co-extruded thin polyester film having an oligomers deposition-preventing property is formed on the said polyester film as the base film and containing a compound having an excellent oligomer deposition-preventing ability, or an oligomer deposition-preventing layer is formed on the coating layer (A) or a co-extruded thin polyester film (A)." (Col. 14, lines 52-60).

The coating layer (A) of substrate (1) described above containing a resin binder and the coating layer (A) of substrate (6) described above containing a heat-resistant resin such as a polyetherimide are two different and unrelated coating layers. The coating layer (A) of substrate (1) is for protuberance-forming (Col. 4, line 18, to Col. 8, line 15). The coating layer of (6) is for preventing oligomer deposition (Col. 14, line 52, to Col. 20, line 44).

Although both layers are labeled "coating layer (A)", the structure, composition and function of the layers are completely independent. For example, the preferable thickness of

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protuberance-forming layer (A) (Col. 8, lines 14-15) is 0.01 to 3 μm . On the other hand, the thickness of oligomer deposition preventing layer (A) is 0.0001 to 10 μm (Col. 19, line 49). Moreover, in Kinoshita the polyester resin binder is used only for the protuberance-forming layer and a heat-resistant resin is used only for the oligomer deposition preventing layer. This may be seen by referring to in Examples 8 and 9. In each of these examples, a protuberance-forming layer containing an aqueous polyester as a polyester binder resin was first coated on a base polyester film. Then, an oligomer deposition preventing layer containing γ -aminopropyltriethoxysilane (Example 8) or polysulfone (Example 9) was coated on the obtained polyester film. The two layers were laminated but not mixed. None of the examples of Kinoshita disclose a combination of polyester binder and polyetherimide and no motive is provided in Kinoshita or the other prior art to combine a polyetherimide with a polyester resin binder in the protuberance-forming layer of substrate (1) of Kinoshita.

Removal of the 35 U.S.C. § 103(a) rejection and a notice of allowability of the present application are believed to be in order and are respectfully solicited.

The foregoing is believed to be a complete and proper response to the Office Action dated November 5, 2004, and is believed to

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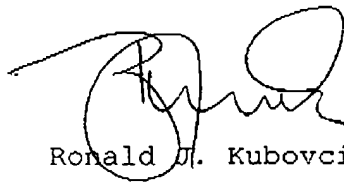
place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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